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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/311,674 05/13/99 KATZ

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EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2764

4

DATE MAILED: 02/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/311,674

Applicant(s)

Katz

Examiner

Robert Weinhardt

Group Art Unit

2764



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-29 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2764

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: Parent application 08/728,921 cited on page 1 of the specification has issued as a patent, the citation is required to be updated to reflect this.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. Claims 6, 11, 13 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6, 11, 13 and 22, the term "collared" is not clear. For the purposes of examination, "collared" will be assumed to mean "Caller-ID".

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 2764

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-29 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 5,963,912 and claims 1-24 of U. S. Patent No. 5,646,839 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents since the patents and the application are claiming common subject matter, as follows:

Instant claim 1 for example recites enabling the detection of data indicating the origin of telephone calls, enabling the reception of identification data from the calling telephones, enabling verification of the identification data against reference data, enabling the creation of call records and stamping call records and enabling the generation of a report. Each of these features is found in claim 1 of the '912 patent and claim 1 of the '839 patent. As the instant application is a continuation of the application that matured into the '912 patent and as that application of the '912 patent was a continuation of the '839 patent, these three applications have a common specification.

Art Unit: 2764

Thus, any difference between these claims must be fully supported by the common specification and overlapping protection provided by the patented claims as a result of the use of the term "comprising" in the instant and patented claims. Similarly, all of the remaining claims in the instant application are fully supported by the common specification in all applications and thus overlapping protection is provided by the patented claims as a result of the use of the term "comprising" in the claims

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 1-5, 7-10, 12, 14-21 and 23-29 are rejected under the judicially created doctrine of double patenting over claims 1-27 of U. S. Patent No. 5,255,183 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Instant claim 1 for example recites enabling the detection of data indicating the origin of telephone calls, enabling the reception of identification data from the calling

Art Unit: 2764

telephones, enabling verification of the identification data against reference data, enabling the creation of call records and stamping call records and enabling the generation of a report. Each of these features is found in claim 1 of the '183 patent. While the instant application is related to the '183 patent through a CIP application, substantial common subject matter exists. Any difference between these claims is fully supported by the common portions of the specification and thus, overlapping protection provided by the patented claims as a result of the use of the term "comprising" in the instant and patented claims. Similarly, all of the remaining claims cited above in the instant application are fully supported by the common portions of the specification and thus overlapping protection is provided by the patented claims as a result of the use of the term "comprising" in the claims

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,963,912, claims 1-24 of U. S. Patent No, 5,646,839, and claims 1-27 of U. S. Patent No. 5,255,183, all to Katz. Although the conflicting claims are not identical, they are

Art Unit: 2764

not patentably distinct from each other because the deletion of elements with a corresponding loss of function would have been obvious to those of ordinary skill in the art.

Claim 1 of the instant application is directed to a computer software product comprising code means for enabling the detection of data indicating the origin of telephone calls, code means for enabling the reception of identification data from the calling telephones, code means for enabling verification of the identification data against reference data, code means for enabling the creation of call records and stamping call records and code means for enabling the computer to generate a report. While claims 1 and 10 of the '912 patent are directed to a method and a system respectively, the method performs steps similar to the functions of the code means and includes the use of a computer system and the recited system also performs similar functions via a computer. Official Notice is taken that computer software products including code means to enable computer operations are well known. Thus, it would have been obvious to those of ordinary skill in the art that the computer in the method or system of claims 1 or 10 of the '912 patent would have operated according to a computer software product.

Further, while the method and system of patented claims 1 and 10 include additional limitations such as limitations directed to tracking an employee, deletion of features with a corresponding loss of function would have been obvious to those of

Art Unit: 2764

ordinary skill in the art. See *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963). Claim 1 of each of the '183 and '839 patents contain similar limitations and thus instant claim 1 is rejected for similar reasons. With respect to the instant dependent claims these limitations are found amongst the patented dependent claims, save for the recitation of Caller-ID in the '183 patent. However, Official Notice is taken that Caller-ID is well known in the art to provide identification of the calling number. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of the '183 patent to include Caller-ID as an obvious matter of substitution for ANI to provide identification of the calling number using commercially available technology.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address: robert.weinhardt@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Application/Control Number: 09/311,674

Page 8

Art Unit: 2764

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

February 14, 2000

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER